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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,644 09/15/98 DOBBS

S 05015.0175

HM12/0329

NEEDLE & ROSENBERG
SUITE 1200 THE CANDLER BUILDING
127 PEACHTREE STREET NE
ATLANTA GA 30303-1811

EXAMINER

MCQUEENEY, F

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/153,644

Applicant(s)

DOBBS ET AL.

Examiner

P. E. McQueeney

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5&6.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

Art Unit: 1615

DETAILED ACTION

1. Acknowledgement is made of applicant's response to notice to file missing parts of application filed November 9, 1998, information disclosure statements filed September 15, 1998 and March 15, 1999 and status inquiry filed February 29, 2000.

Claim Rejections - 35 USC § 112

2. Claims 44-47 recite the limitation "isopropanol" in claim 34. There is insufficient antecedent basis for this limitation in the claim. Claim 34 comprises ethanol. Claim 43 comprises isopropanol. The application has been reviewed as though the reference to claim 34 in claims 44-47 actually is to claim 43. Please clarify.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahieu et al. Mahieu et al. disclose novel copolymers with a base of N-alkyl acrylamide or methacrylamide and their uses in cosmetics particularly in setting lotions and lacquer and in other preparations such as, for example, nail polish. Mahieu et al. disclose claim

Art Unit: 1615

1, 4 and 31 of the present invention in Example L. Applicant claims the same composition. Future intended use does not confer patentability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-4, 8 and 14-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahieu et al. as applied to claims 1, 4 and 31 above.

Mahieu et al. disclose the use of propellants at column 5, lines 26-33. Mahieu et al. disclose that the polymers can be introduced into the composition in the form of aqueous or water-alcohol solutions at column 5, lines 41-46. Mahieu et al. pre-

Art Unit: 1615

neutralize the polymer at column 4, lines 48-55. Mahieu et al. disclose the use of isopropanol or ethanol at column 4, lines 64-66.

It is the position of the examiner that the composition percentages are limitations that would be routinely determined by one of ordinary skill in the art through minimal experimentation as being suitable absent the presentation of some unusual or unexpected results. The results must be those that occur from the specific limitations.

Mahieu et al. do not disclose a hairspray composition. It is the position of the examiner that one of ordinary skill in this art, at the time of the invention, would find it obvious to use the composition of Mahieu et al. as a hair spray because Mahieu et al. teaches the use of their copolymers in setting lotions and lacquers in addition to nail polish. The expected result would be a hair spray composition that contains a reduction in volatile organic compounds but still provides a good holding of the hairdo.

5. Claims 1-5, 8-11 and 14-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahieu et al. as applied to claims 1-4, 8, 14-48 above, and further in view of Halloran et al. Mahieu et al. do not disclose the use of an octylacrylamide-acrylate-butylaminoethyl-methacrylate copolymer nor the use of dimethyl ether, butane or propane as propellants. Halloran et al. disclose that this is a currently-used copolymer and also that this polymer is suitable for alcohol based formulations such as hairsprays and pumps (column 1, lines 49-61). Halloran et al. also disclose dimethyl ether, propane or butane as propellants that are part of an aerosol delivery system

Art Unit: 1615

(column 1, lines 45-48). It would have been obvious to one of ordinary skill in this art to use the particular polymer and propellant of Halloran et al. in the composition of Mahieu et al. in order to provide an easily available film-forming agent. The expected result would be a cheaper composition.

6. Claims 1-4, 6-12, 14-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahieu et al. as applied to claims 1-4, 8, 14-48 above, and further in view of Adams et al. Mahieu et al. do not disclose the use of water dispersible polyesters copolymer nor the use of dimethyl ether, butane or propane as propellants. Adams et al. disclose that the use of water-dispersible linear sulfopolyesters in hair spray formulations has been disclosed (column 1, lines 27-28). Adams et al. further disclose an improved sulfopolyester. Adams et al. disclose the use of dimethyl ether, propane and butane as propellants in column 5, lines 15-30. It would have been obvious to one of ordinary skill in this art to use the particular polymer and propellant of Adams et al. in the composition of Mahieu et al. in order to provide an improved film-forming agent. The expected result would be a non-tacky and fast-drying composition.

Claims 1-4, 8 and 13-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahieu et al. as applied to claims 1-4, 8 and 14-48 above, and further in view of Tong. Mahieu et al. do not disclose the specific propellant of applicant's claim 13 (1,1-difluoroethane). Tong discloses typical propellants in column

Art Unit: 1615

7, lines 51-54. 1,1-difluoroethane is listed among them. It would have been obvious to one of ordinary skill in this art to use the propellants of Tong in the invention of Mahieu et al. in order to reduce the VOC of the final product. The expected result would be

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. E. McQueeney whose telephone number is 703-306-5827. The examiner can normally be reached on weekdays from 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



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Receipt is acknowledged of applicants Status Letter filed 03-06-00 . The application is assigned to examiner Patricia McGreeney whose telephone number is 703-306-5827 . If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on 703-308-2927. The application is assigned to Art Unit 1615. Any inquiry of a general nature of this application should be directed to the Group receptionist whose telephone number is 703-308-1235.

This application was filed 09-15-98 . It is expected that an action in this case will be mailed within 1 week from the mailing of this letter.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 1600

Thurman K. Page
Supervisory Patent Examiner
Group 1600 Art Unit 1615